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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
PAULA, CESAR B	
ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/312,255	MOHAN ET AL.	
	Examiner	Art Unit	
	CESAR B PAULA	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 October 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8-33 and 37-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *37-39* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This action is responsive to the amendment filed on 10/9/2002.

This action is made Final.

2. In the amendment, claims 1-7, and claims 34-36 have been canceled. Claims 37-39 have been added. Claims 8-33, and 37-39 are pending in the case. Claims 8, 18, 20, and 37-39 are independent claims.

Drawings

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 19 recites the limitation "the bookmark" in line 1. There is insufficient antecedent basis for this limitation in the claim. It seems that this claim is supposed to depend on claim 18.

Election/Restrictions

5. The election of claims 8-33 has been affirmed by the Applicants.

6. Restriction to one of the following inventions is required under 35 U.S.C 121:

Group I. Claims 8-33, drawn to a method for filling out a form by connecting to a server, classified in Class 707, subclass 507.

Group II. Claims 37-39, drawn to a method for adding a homepage, history list, and cookies to a web page, classified in Class 707, subclass 513, and Class 345, subclass 745, 760.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Because the inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, search for Group II is not required Group I.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 8-10, 12-15, and 17, remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis (Pat. # 5,794,259, 8/11/98), in view of Lieberman et al, hereinafter Lieberman (Pat. # 6,353,822, 3/5/2002, filed on 8/22/96).

Regarding independent claim 8, Kikinis discloses retrieving a form over the Internet from a server to a client computer (col.2, lines 21-56, and col. 3, lines 58-67).

Moreover, Kikinis discloses requesting and receiving a request to fill out a form (col.2, lines 21-56, and col. 3, lines 58-c.4,line 67).

Moreover, Kikinis fails to explicitly disclose: *connecting to a destination server through an independent intermediary mechanism (IIM)*. However, Lieberman teaches the connecting of a server over the Internet through memory modules—*IIM—independent of the server* (col.5, lines 31-col.6, line 33). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Kikinis, and Lieberman, because Lieberman teaches above the interaction of the computer modules with other independent hardware components.

Furthermore, Kikinis fails to explicitly disclose: *filling in the form from a database in the IIM*. However, Lieberman teaches the storing of preference information in memory modules—*IIM*—(col.5, lines 31-col.6, line 33). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Kikinis, and Lieberman, because Lieberman teaches above the interaction of the computer modules with other independent hardware components.

Regarding claim 9, which depends on claim 8, Kikinis filling in a form from a transaction database if it is determined that a user profile is present (col. 1, lines 45-67, col. 3, lines 58-col.4, line 67).

Regarding claim 10, which depends on claim 9, Kikinis teaches filling in a form from a transaction database if it is determined that a user profile is present (col. 1, lines 45-67, col. 3, lines 58-col.4, line 67). Kikinis fails to explicitly disclose: *determining if the user has changed an item in a user profile that is used in the form.* However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to performed this step, when a user updates the profile, because Kikinis teaches above the filling in of forms with a user profile.

Claims 12-13 are directed towards a method for implementing the steps found in claim 1, and therefore is similarly rejected.

Regarding claim 14, which depends on claim 12, Kikinis teaches filling in a form from a transaction database if it is determined that a user profile is present (col. 1, lines 45-67). Kikinis fails to explicitly disclose: *the form database comprises multiple databases, at least one of the databases is centrally maintained.* However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to performed this step, because Kikinis teaches above the filling in of forms with a user profile over the Internet.

Regarding claim 15, which depends on claim 12, Kikinis teaches retrieving a newly opened form at a new address over the Internet (col. 1, lines 45-67).

Moreover, Kikinis teaches the filling in and associating of the newly opened form fields "identifiers" with data from a user profile in a database (col.3, 16-67).

Furthermore, Kikinis fails to explicitly disclose: *storing the new form, the new address, and the associated form control identifiers*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to performed this step, because Kikinis teaches above the filling in of forms with a user profile to be submitted over the Internet.

Claims 17, is directed towards a method for implementing the steps found in claims 10, and therefore is similarly rejected.

11. Claim 11 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis, in view of Lieberman, and further in view of Freivald et al, hereinafter Freivald (Pat. # 5,983,268, 11/9/1999, filed on 3/25/97).

Regarding claim 11, which depends on claim 10, Kikinis discloses requesting and receiving a request to fill out a form (col.2, lines 21-56, and col. 3, lines 58-67). Kikinis fails to explicitly disclose: *comparing a date of the transaction record with a date of changes in the user profile; and if the date of the transaction record is older, determining if the changes in the user profile are of a relevant record.* However, Freivald teaches the comparison of a document's transaction date with a threshold value to determine if the document contains a relevant update (col.2, line 62-col.3, line 44). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Kikinis, Lieberman, and Freivald because Freivald teaches an update detection tool to avoid manual update detection.

12. Claim 16 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis, in view of Lieberman, and further in view of Morgan et al, hereinafter Morgan (Pat. # 6,073,140, 7/29/1997, filed on 7/29/97).

Regarding claim 16, which depends on claim 12, Kikinis discloses requesting and receiving a request to fill out a form (col.2, lines 21-56, and col. 3, lines 58-67). Kikinis fails to explicitly disclose: *the form database is maintained in a central location, and administered by an authorized updater.* Lieberman teaches the accessing of a server over the Internet through memory modules—*IIM*—(col.5, lines 31-col.6, line 33). However, Morgan teaches the update of a database by a user to update a database from a central location (col.3, lines 34-67, and col.12, lines 16-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Kikinis, Lieberman, and Morgan, because Morgan teaches above the facilitating of enhancement of a central document database.

13. Claims 18-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis, in view of Nielsen (Pat. # 5,963,964, 10/5/99, filed on 4/5/96).

Regarding independent claim 18, Kikinis discloses retrieving a form over the Internet (col. 3, lines 58-67). Kikinis fails to explicitly disclose: *accessing a destination server through an independent intermediary mechanism (IIM); adding the URI as a bookmark in a database in the IIM to allow user by connections through IIM.* Lieberman teaches the storing of preference information in memory modules—*IIM*—(col.5, lines 31-col.6, line 33). However, Nielsen teaches receiving an indication from a user to save a bookmark for locating a web page—URI--located at a remote server (col.2, lines 48-col.3, line 47). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Kikinis, Lieberman, and Nielsen, because Nielsen teaches above the creation, selection, and saving of document bookmarks.

Regarding claim 19, which depends on claim 16, Kikinis, and Nielsen fail to explicitly disclose: *the bookmark is located within a user database on the IIM.* However, Lieberman teaches the storing of preference information in memory modules—*IIM*—(col.5, lines 31-col.6, line 33). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Kikinis, Nielsen, and Lieberman, because Lieberman teaches above the interaction of the computer modules with other independent hardware components.

14. Claims 20-33 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis, in view of Gupta et al, hereinafter Gupta (Pat. # 6,199,079, 3/6/2001, filed on 3/20/1998).

Regarding independent claim 20, Kikinis discloses requesting and receiving a request to fill out a form (col.2, lines 21-56, and col. 3, lines 58-67). Kikinis fails to explicitly disclose: *accessing a destination server through an independent intermediary mechanism (IIM).* However, Lieberman teaches the accessing of a server over the Internet through memory modules—*IIM*—(col.5, lines 31-col.6, line 33). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Kikinis, and Lieberman, because Lieberman teaches above the interaction of the computer modules with other independent hardware components.

Moreover, Kikinis discloses retrieving a form over the Internet (col. 3, lines 58-67). Kikinis fails to explicitly disclose: *accessing a destination server through an independent intermediary mechanism (IIM).* However, Gupta teaches accessing the tracking of an order, after a form has been filled in (col.8, lines 1-65). It would have been obvious to a person of ordinary

skill in the art at the time of the invention to have combined the teachings of Kikinis, and Gupta, because Gupta teaches above the subsequent tracking of an electronic transaction.

Regarding claim 22, which depends on claim 20, Kikinis teaches filling in a form from a transaction database if it is determined that a user profile is present (col. 1, lines 45-67, col. 3, lines 58-col.4, line 67). Kikinis fails to explicitly disclose: *updating a user profile based on information submitted in the form*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to performed this step, when a user updates the profile, because Kikinis teaches above the filling in of forms with a user profile.

Claims 21, 26-29, 31-32 are directed towards a method for implementing the steps found in claims 10, 1, 1, 1, 1, 15, 15, and 16 respectively, and therefore are similarly rejected.

Claims 23-24 are directed towards a method for implementing the steps found in claim 20, and therefore are similarly rejected.

Regarding claim 25, which depends on claim 20, Kikinis discloses requesting and receiving a request to fill out a form (col.2, lines 21-56, and col. 3, lines 58-67). Kikinis fails to explicitly disclose: *selectively turn on and off the transaction recording facility*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have performed this well known step of turning on an application, because Lieberman teaches filling out of forms using computer applications.

Claims 30, 33, are directed towards a method for implementing the steps found in laims 13, 13, respectively, and therefore are similarly rejected.

Response to Arguments

15. Applicant's arguments filed 10/9/02 have been fully considered but they are not persuasive. In response to applicant's argument concerning claim 8, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "IIM is defined in the Detailed Description...a system that 'includes both server and client components where the server component handles all remote transaction'...) p.8,L.3-19, are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Kikinis teaches a server for handling the remote transactions requested by a client's browser (c.1,L.45-67, c.3,L.32-67).

Claims 9-10, 12-15, and 17 depend on claim 8, and are therefore rejected for the same reasons stated above.

Regarding claims 8, and 11, the Applicants indicate that Freivald fails to teach connecting to a server through an IIM (p.10,L.10-24). Kikinis teaches a server for handling the remote transactions requested by an client's browser (c.1,L.45-67, c.3,L.32-67). Lieberman teaches the accessing of a server through server-independent memory modules (c.5,L.31-c.6,L.33, fig.1)

Regarding claim 16, the Applicants indicate that Morgan fails to teach or suggest the use of a web browser for connecting to a server (p.11,L.10-14). The Examiner disagrees, because Morgan does teach updating a database through the Internet (c.12, L.16-67), so that it would have been clearly obvious to one of ordinary skill to combine Morgan to maintain a form at a central location and be updated by an authorized person.

Regarding claim 18, the Applicants note that Nielsen fails to teach or suggest connecting to a server through an IIM (p.12,L.6-17). As the Examiner pointed out above, Lieberman teaches a server for handling the remote transactions requested by an server-independent client's memory modules.

Regarding claims 20-33, the Applicants note that Gupta fails to teach or suggest connecting to a server through an IIM (p.13,L.6-17). As the Examiner pointed out above, Lieberman teaches a server for handling the remote transactions requested by an server-independent client's memory modules.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nishiyama et al. (Pat. # **6,421,693**).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

- **(703) 746-7238**, (for **After Final** communications intended for entry)
- **(703) 746-7239**, (for **Formal** communications intended for entry, **except formal After Final communications**)

Or:

- **(703) 746-7240**, (for **Informal or Draft** communications for discussion only, please label "**PROPOSED**" or "**DRAFT**").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,

Arlington, VA, Sixth Floor (Receptionist).

CBP

12/30/02

STEPHEN S. HONG
PRIMARY EXAMINER